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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/824,203

04/14/2004

Najem Yaqub

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SALTER & MICHAELSON  
THE HERITAGE BUILDING  
321 SOUTH MAIN STREET  
PROVIDENCE, RI 029037128

EXAMINER

KARPINSKI, LUKE E

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/824,203	<b>Applicant(s)</b> YAQUB ET AL.	
	<b>Examiner</b> LUKE E. KARPINSKI	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/30/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Receipt of Amendment and Arguments/Remarks filed 7/30/2008 is acknowledged.

### ***Claims***

Claims 1-35 are amended, currently pending and under consideration in this action.

### ***Rejections***

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites "allowed to stand the viscosity of the mixture and therefore its gel rigidity increases". This claim seems to be missing language as to what the viscosity does. In view of the fact that the gel rigidity is increasing the examiner will interpret claim 35 as though the viscosity is increasing. Clarification on this matter is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**1. Claims 1-4, 6-13, and 17-19, 21-23, 25-28, and 30-35 are rejected under 35 U.S.C. 103(a)** as being unpatentable over US Patent No. 4,772,427 to Dawson et al.

### ***Applicant Claims***

Applicant claims a method for manufacture of a post-foaming composition, comprising: adding a gelling agent to a mixture comprising an anionic surfactant in an amount to achieve a 4:1 ratio with said gelling agent, combining said mixture with a post-foaming agent, and filling packages with said mixture prior to gel formation. Applicant also claims said gel forming at least 4 minutes after the addition of said post-foaming agent, said gel structure being stable for 12 months, the gel structure only formed at least 4 minutes after addition of the post foaming agent, and said mixture packaged into final containers prior to gel formation.

Applicant further claims are specific gel agents, including laureth-4, a percentage range for said gel agent, amphoteric surfactants and a percentage range thereof, a saturated aliphatic hydrocarbon, a percentage range for said post-foaming agent, and the gel rigidity remaining unchanged for at least 10 minutes after addition of the post-foaming agent.

***Determination of the Scope and Content of the Prior Art***

***(MPEP §2141.01)***

Dawson et al. teach methods of making post-foaming gel compositions (col. 8, line 53 to col. 9, line 2), comprising anionic surfactants (abstract), an anionic surfactant to non-ionic gelling agent of 4:1 or greater (abstract), filling said mixtures into packaging prior to gel formation (col. 8, line 61 to col. 9, line 19), said gel forming up to 24 hours after the addition of the post foaming agent (col. 8, line 61 to col. 9, line 19), and filling said compositions into the final container prior to gelling (col. 8, line 61 to col. 9, line 19), as claimed in claim 9.

Dawson et al. further teach polyoxyethylene (4) lauryl alcohol, also known as Brij 30 and laureth-4, (col. 4, lines 49-65) as claimed in claims 1-3 and 11, 7% of a gelling agent present, which reads on 0.01-8% (col. 10, examples 9 and 10), as claimed in claims 4, 12, and 13, 0.01-30% surfactant present (col. 10, examples 3 and 4), as claimed in claims 6 and 17-19, a saturated aliphatic hydrocarbon with 4-5 carbon atoms (abstract and col. 5, lines 20-26), as pertaining to claims 7 and 21-23, and 25, 0.01-14% post-foaming agent present (col. 5, lines 20-26, col. 9, example 1, and col. 10, lines 55-

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57), as claimed in claims 8 and 26-28, and 30-31, sodium lauryl ether sulphate (SLS) (col. 4, lines 22-30), as claimed in claim 32, alkali metal alkyl ether sulfates (col. 10, examples 3 and 4), as claimed in claim 33, and iso-pentane (col. 5, lines 26), as claimed in claim 34.

***Ascertainment of the Difference between Scope the Prior Art and the Claims  
(MPEP §2141.012)***

Dawson et al. do not teach said formulations stable for 12 months at 25° C or below as claimed in claim 9. However, Dawson et al. do teach stable compositions (abstract and col. 3, lines 24-26).

***Finding of Prima Facie Obviousness Rational and Motivation  
(MPEP §2142-2143)***

Regarding claim 9, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Dawson et al. with the property of remaining stable for at least 12 months under certain conditions.

One of ordinary skill in the art would have been motivated to do this because Dawson et al. teach said formulations as stable and one would have wanted such a consumer product to remain stable for at least 12 months to account for shipping time as well as time spent on the store shelves or being stored/utilized by a consumer. Therefore it would have been obvious to optimize the formulations of Dawson et al. to

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remain stable for at least 12 months, in order to provide a product with sufficient shelf life.

Further regarding claim 9, it would also be expected that compositions comprising of the same components in the same amounts would remain stable for the same amount of time when stored under the same conditions. The Office does not have the facilities capable of testing the length of time that the compositions disclosed by Dawson et al. will remain stable, therefore the burden has been shifted away from the office and it is now incumbent upon Applicant to show that the compositions disclosed in Dawson et al. would not remain stable.

Further regarding claims 9 and 10, Dawson et al. teach that the gel may be formed anytime from immediately after addition of said agent to 24 hours later. It is reasonable to state that one of ordinary skill would have known that manufacture and packaging of said formulations is easier when said formulation is in liquid form, not gel form, and knowing that the gel formation could be timed for up to 24 hours after addition of said gelling agent one could have timed such formation for after all processing was completed and said formulation was packaged, which could be 4 minutes or greater. The limitation of said formulation being **only** formed at least 4 minutes after the addition does not overcome Dawson et al. because Dawson et al. still teach that the gelling time is flexible, and in the timeline of immediately to 24 hours, a majority of said range is at least 4 minutes.

Further regarding claim 9, Dawson et al. teach both, said formulations piped into storage containers prior to gelling and said formulations mixed and formed in the final



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container. The art clearly teaches embodiments wherein said formulations are dispensed into containers prior to gelling, one embodiment in final aerosol containers and another into larger storage containers, which could be sold as final containers for industrial purposes.

Regarding claim 35, the viscosity and therefore the gel rigidity of said formulations would necessarily increase after said formulations were dispensed into containers and allowed to stand. Dawson et al. teach gelling after said formulations are dispensed into containers and a liquid composition would necessarily have a lower viscosity and gel rigidity than a gel composition of the same components.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**2. Claims 5, 14-16, 20, 24, and 29 are rejected under 35 U.S.C. 103(a)** as being unpatentable over US Patent No. 4,772,427 to Dawson et al. in view of International publication No. WO 97/03646 to Hall et al.

### ***Applicant Claims***

Applicant claims the composition in the method of claim 9 further comprising an amphoteric surfactant.

***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

The teachings of Dawson et al. are delineated above and incorporated herein. In particular, Dawson et al. teach post-foaming gel compositions comprising surfactants.

***Ascertainment of the Difference between Scope the Prior Art and the Claims (MPEP §2141.012)***

Dawson et al. do not teach an amphoteric surfactant as claimed in claim(s) 5, and 14-16. This deficiency in Dawson et al. is cured by Hall et al. Hall et al. teach the utilization of amphoteric surfactants in post-foaming gel compositions (page 7, line(s) 8-17).

***Finding of Prima Facie Obviousness Rational and Motivation (MPEP §2142-2143)***

Regarding claims 5 and 14-16, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Dawson et al. with an amphoteric surfactant as taught by Hall et al. in order to produce the invention of instant claims 5 and 14-16.

One of ordinary skill in the art would have been motivated to do this because Dawson et al. and Hall et al. are analogous art, teach to similar compositions, and Hall et al. teach that such compositions may comprise a mixture of surfactants, including amphoteric surfactants. Therefore it would have been obvious to utilize the amphoteric surfactants of Hall et al., within the post-foaming gel compositions of Dawson et al. in

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order to impart the properties and feel of an amphoteric surfactant onto said formulations.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Response to Arguments***

Although all rejections have been withdrawn based on amendment any arguments which pertain to the new grounds of rejection are answered below.

Applicant's arguments filed 7/30/2008 have been fully considered but they are not persuasive.

Applicant argues that, as now claimed the gel is defined as **only** formed at least 4 minutes after the addition of the post-foaming agent.

This argument is not persuasive because the rejection against said claim is an obviousness type rejection and Dawson et al. still teach a range of gelling, which, by a majority is over 4 minutes.

Applicant also argues that the ratio of anionic surfactant to non-ionic gelling agent is greater than 4:1.

This argument is not found persuasive because applicant claims a ratio of 4:1 **or** greater; therefore a ratio of 4:1 reads on the claim.

Applicant also argues that the instant method fills containers with said formulation prior to gelling and that Dawson et al. teach gelling prior to introduction into a final container.

This argument is not found persuasive because this limitation is taught by Dawson et al. as discussed above in the 103 rejection. Dawson et al. teach several embodiments, one of which is the addition of all components into a final container, in which the gelling takes place, and another in which said composition is introduced into a storage container, which could very well be a final container. It is viewed as obvious to add said non-gelled composition into any container.

Applicant also argues that once the mixture has been filled into said package and allowed to stand, the viscosity and therefore the gel rigidity of said mixture increases.

This argument is not found persuasive because Dawson et al. teach the addition of said non-gelled mixture into containers, therefore the gelling process occurs within said container. A gel composition is necessarily more viscous and has a higher gel rigidity than a non-gel form of the same composition. Therefore the formulations of Dawson et al. necessarily meet this limitation.

### ***Double Patenting***

Claims 2-4 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/824,202.

This is a provisional obviousness-type double patenting rejection.

***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

Dawson et al. '202 claims a method for manufacture of a composition comprising, adding a non-ionic gelling agent to an anionic surfactant at a ratio of 1:4 or less, combining said mixture with a post-foaming agent, and filling said mixture into a container prior to gel formation, wherein the gel rigidity remains unchanged for at least 4 minutes. '202 also claims a list of different gelling agents and a percentage thereof.

***Ascertainment of the Difference between Scope the Prior Art and the Claims (MPEP §2141.012)***

Dawson et al. '202 do not teach the said compositions remaining stable for at least 12 months at a specified temperature.

***Finding of Prima Facie Obviousness Rational and Motivation (MPEP §2142-2143)***

It would also be expected that compositions comprising of the same components in the same amounts would remain stable for the same amount of time when stored under the same conditions. The Office does not have the facilities capable of testing the length of time that the compositions disclosed by Dawson et al. '202 will remain stable, therefore the burden has been shifted away from the office and it is now incumbent upon Applicant to show that the compositions disclosed in Dawson et al. would not remain stable.

***Conclusion***

Claims 1-35 are rejected.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Mina Haghighatian/  
Primary Examiner, Art Unit 1616

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